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EXAMINER

REESE, DAVID C

ART UNIT PAPER NUMBER

3677

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,515

Applicant(s)

BUSKOP, JACQUELINE EYVYNNE
BREUNINGER

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to Applicant's amendment filed 2/3/2006.

Status of Claims

- [1] Claims 1-2, 4-10, and 12-14 are pending.

Claim Rejections - 35 USC § 103

- [2] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- [3] Claims 1-2, 4-10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westmoland US-5,201,578, in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Westmoland teaches of lighted jewelry (Fig. 8) comprising:

- a. at least one earring clip (10 in view of col. 2, line 10, "For example, an ear clasp may be connected to the article of jewelry allowing it to be worn as an earring for pierced or non-pierced ears," as well as from col. 4 lines 15-20) with back side and front side for engaging a non-pierced ear;

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b. at least one hook (10b; from col. 7, beginning with line 4, “Attachable to either the split rings via 4b, or loop 31, may be decorative elements, 29, in this case fine chains...” secured to said earring clip (10);

c. at least one edible food item removably secured to said hook (10b; col. 7 beginning with line 4, “Attachable to either the split rings via 4b, or loop 31, may be decorative elements, 29, in this case fine chains...” further, “Alternatively, charms, small crystals, reflectors or other such elements having interesting or pleasing visual effects may be so attached”), wherein said edible food item is selected from the group: a fruit, a vegetable, and combinations thereof. (Further, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

d. an automatic LED disposed on a lower portion of the front side for lighting the edible food item (4; from col. 3, beginning with line 16, “Lighting elements 4 may be incandescent bulbs...or they may be light emitting diode, LED, devices...leads may be shortened so that the lighting elements 4 are positioned closed against the edge of the jewelry article”).

Re: Claim 2, wherein at least one hook (10b) comprises at least two hooks (1st, 2nd, and 3rd 10b of Fig. 8) connected in series.

Re: Claim 4, wherein said LED light is a blinking LED light that can be actuated with a switch secured to said earring clip (Col. 4, 58-66; col. 5, lines 15-58, specifically, “The microchip may be designed to provide a controlled pattern of flashing to the lighting elements...” and further, “To effect such control the microchip element is

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attachable to either plate...as to be included in the circuit...and lastly, "apertures 24 are located and sized to accept contact pins 22 extending from microchip element 17 to provide electrical contact between microchip 19 and lighting element leads 5." Further, it has been held that broadly providing a mechanical or automatic means (switch) to replace manual activity (inserting the contact pins or inserting the battery for light activation), which has accomplished the same result, involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Re: Claim 5, wherein said hook is between 1.5 inches and 3 inches in overall length (Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Re: Claim 6, wherein said hook (10b) is adapted to have at least a first prong and an second prong (split rings have two non-adjoining ends, which can be considered a first

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and second prong) [for engaging at least two food items] (Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

Re: Claim 7, wherein the edible food item is selected from the group: blueberries, strawberries, dried fruits, blackberries, cherry tomatoes, kiwi fruitsfruits with similar sturdy yet pierce-able skins, and vegetables with similar sturdy yet pierce-able skins (col. 7 beginning with line 4, “Attachable to either the split rings via 4b, or loop 31, may be decorative elements, 29, in this case fine chains,” further, “Alternatively, charms, small crystals, reflectors or other such elements having interesting or pleasing visual effects may be so attached” Further, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

As for Claim 8, Westmoland teaches of lighted jewelry (Fig. 8) comprising:

- a. at least one earring clip (10 in view of col. 2, line 10, “For example, an ear clasp may be connected to the article of jewelry allowing it to be worn as an earring for pierced or non-pierced ears,” as well as from col. 4 lines 15-20) with back side and front side for engaging a non-pierced ear;
- b. at least one hook (10b; from col. 7, beginning with line 4, “Attachable to either the split rings via 4b, or loop 31, may be decorative elements, 29, in this case fine chains...”) secured to said earring clip (10);

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c. at least one chewy candy item removably secured to said hook (col. 7 beginning with line 4, “Attachable to either the split rings via 4b, or loop 31, may be decorative elements, 29, in this case fine chains,” further, “Alternatively, charms, small crystals, reflectors or other such elements having interesting or pleasing visual effects may be so attached” Further, note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

d. an automatic LED disposed on a lower portion of the front side for lighting the edible food item (4; from col. 3, beginning with line 16, “Lighting elements 4 may be incandescent bulbs...or they may be light emitting diode, LED, devices...leads may be shortened so that the lighting elements 4 are positioned closed against the edge of the jewelry article”).

Re: Claim 9, wherein said candy is selected from the group: soft licorice, soft raspberries, juicy fruits, and like soft candies (note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

Re: Claim 10, further comprising a line (5) wherein said hook (10b) connects said line (5) near said earring clip (10) and a second hook (1st segment of 29) connects to said line (5) further from said earring clip (10) than said hook (10b).

Re: Claim 12, wherein said LED light is a blinking LED light that can be actuated with a switch secured to said earring clip (Col. 4, 58-66; col. 5, lines 15-58, specifically,

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“The microchip may be designed to provide a controlled pattern of flashing to the lighting elements...” and further, “To effect such control the microchip element is attachable to either plate...as to be included in the circuit...and lastly, “apertures 24 are located and sized to accept contact pins 22 extending from microchip element 17 to provide electrical contact between microchip 19 and lighting element leads 5.” Further, it has been held that broadly providing a mechanical or automatic means (switch) to replace manual activity (inserting the contact pins or inserting the battery for light activation), which has accomplished the same result, involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Re: Claim 13, wherein said hook is between 1.5 inches and 3 inches in overall length (Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

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Re: Claim 14, wherein said hook (10b) is adapted to have at least a first prong and an second prong (split rings have two non-adjoining ends, which can be considered a first and second prong) [for engaging at least two food items] (Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

Response to Arguments

[4] Applicant's arguments filed 2/3/2006 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. Applicant's primary refutement is based on the fact that Westmoland does not expressly teach the attachment of edible food items to a hook. Applicant confers; however, with the examiner that Westmoland does indeed teach that "or other such elements having interesting or pleasing visual effects" may be use for attachment. Applicant believes that their invention does not provide an interesting or pleasing visual effect, but rather an advertising device. The applicant feels that there is a lack of motivation as to how an edible food item is similar to an element having an interesting or pleasing visual effect. In response, the examiner disagrees with applicant in the instant case, as the examiner believes that something being used for an advertising device would indeed have the potential of being considered as having interesting or pleasing visual effects, since the vendor will be using the device or item from a visual viewpoint (hence advertising) to sell their product (via grabbing an individual's attention). If for example, an individual believes that a piece of candy, fruit, or other edible item has a pleasing visual effect, they may be more inclined to purchase said item, and thus the visual effect of having the edible item dangling as advertisement

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has proved as a successful venture. Consequently, by the very nature of attempting to advertise an item, said item can and is considered as possessing pleasing visual effects, and thus still anticipated by the prior art of Westmoland. In addition, though it has been already stated, please note that the courts have found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

Applicant's second argument concerns how a jeweler would have to be aware of the ancillary, corollary, and atypical use of "food items" such as their application in jewelry before a relationship such as the one proposed by the examiner can be established. In response, the examiner disagrees and believes that the use of "food items" is not "atypical" but rather; quite obvious, and therefore such a relationship can be considered the same.

Third, the applicant states that placing the particular item on the hook is important because it results in a product, which is distinct from the reference product. And thus accordingly, food items should not be referred to as ornamentation only and should be relied upon to patentably distinguish the claimed invention from Westmoland. It is once again important to point out that ornamentation, which has no mechanical function cannot be relied upon to patentably distinguish from the claimed invention. The ability to interchange various pieces of edible items categorizes said items as ornamentations to the structure of the device, ornamentations of which, when you interchange them, have no direct influence on the mechanical function of the device; rather, they advertise a different item to possible buyers. Thus to conclude, it is still considered ornamentation

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because it does not change the mechanical function of the item when compared to Westmoland. Just because Westmoland does not expressly state of an edible item it does not alter the conclusion that its use (edible item) in a prior art device (Westmoland) would be prima facie obvious from the purpose disclosed in the reference.” *In re Lintner*, 173 USPQ 560.

Conclusion

[5] THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

[6] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

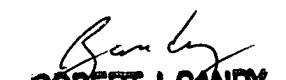
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David Reese
Assistant Examiner
Art Unit 3677

DCR



3/30/06



ROBERT J. SANDY
PRIMARY EXAMINER